



Patty Docket No. 80398.P460

Patent

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:) Examiner: C. Hewitt, II
)
Hiroshi Ogino) Art Unit: 3621
)
Application No. 09/966,540) Confirmation No: 4648
)
Filed: September 27, 2001)
)
For: ELECTRONIC GATHERING OF)
PRODUCT INFORMATION AND)
PURCHASING OF PRODUCTS)
_____)

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

This is an appeal to the Board of Patent Appeals and Interferences from the final decision of the Examiner of Group 3621 mailed February 24, 2005, in which claims 1-29 in the above-identified application were rejected. This Appeal Brief is submitted pursuant to 37 C.F.R. § 41.37(a).

I. REAL PARTY IN INTEREST

The real parties in interest are the co-assignees of the full interest in the invention: Sony Corporation of Tokyo, Japan and Sony Electronics Inc. of New Jersey.

II. RELATED APPEALS AND INTERFERENCES

To the best of Appellant's knowledge, there are no appeals or interferences related to the present appeal that will directly affect, be directly affected by, or have a bearing on the Board's decision in the present appeal.

09/29/2005 SDENB001 00000023 09966540

01 FC:1402

500.00 OP

III. STATUS OF THE CLAIMS

Claims 1-29 are pending in the application and were rejected in a final Office Action mailed February 24, 2005. Claims 1-29 are the subject of this appeal. A copy of Claims 1-29 as they stand on appeal are set forth in Appendix A.

IV. STATUS OF AMENDMENTS

No amendments to the claims have been made after receipt of the Final Office Action.

V. SUMMARY OF CLAIMED SUBJECT MATTER

In claims 1-17 and 26-29, Appellant claims a transaction device that receives a product identifier from a product tag and indirectly transmits the product identifier to a product server to obtain information about the product associated with the product tag. The transaction device transmits the product identifier to a privacy server, which retransmits the product identifier to the product server. (Figure 4, paragraphs 37-38, and Figure 6, paragraphs 44-46) The privacy server authorizes transactions from the transaction device, and also conceals the identity of the user of the transaction device. (Figure 1, paragraphs 16-17) Claims 18-25 claim a system comprising the transaction device and the privacy server.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- I. Claims 7-13 and 15-17 stand rejected under 35 U.S.C. § 112, second paragraph.
- II. Claims 1-4, 6-11, 13, 14 and 26 stand rejected under 35 U.S.C. § 102(e) over U.S. Patent 6,446,871 to Buckley et al.
- III. Claims 5 and 12 stand rejected under 35 U.S.C. § 103(a) over Buckley in view of U.S. Patent 6,434,403 to Ausems et al.
- IV. Claims 15, 17, 18, 20-25, 27 and 29 stand rejected under 35 U.S.C. § 103(a) to Buckley in view of U.S. Patent 6,163,771 to Walker et al.
- V. Claims 16, 19, and 28 stand rejected under 35 U.S.C. § 103(a) to Buckley and Walker in view of U.S. Patent 6,119,101 to Peckover.

VII. ARGUMENTS

I. Claims 7-13 and 15-17 are Definite under 35 U.S.C. § 112, second paragraph.

Appellant notes that the summary for the § 112 rejections in the final Office Action stated that claims 7-13 and 13-15 were rejected. However, the specific rejections were directed to claims 7-13 and 15-17.

Claims 7-13

Claims 7-13 stand and fall together; claim 7 is the representative claim.

The Examiner asserts that claim 7 is imprecise because the preamble recites a “transaction device” but the claim includes a “privacy system” limitation. However, Appellant’s claim recites a “wireless module” and that this module is configured to “transmit through a privacy system.” Appellant is not claiming the privacy system *per se*, but is limiting the scope of the claimed transaction device to one that interacts with a particular type of privacy system. A claim satisfies 35 U.S.C. § 112, ¶ 2 when the scope of the claim can be determined by one of skill in the art. Indeed, instead of making the claim 7 vague, Appellant’s delineation of a particular type of privacy server more clearly defines the boundaries of the claimed subject matter.

Accordingly, Appellant respectfully requests the withdrawal of the rejection of claims 7-13 under 35 U.S.C. § 112, second paragraph.

Claims 15-17

Claims 15-17 stand and fall together; claim 15 is representative claim.

The Examiner asserts that claim 15 contains specific instances of improper antecedent basis. Appellant corrected these instances in the response mailed November 11, 2004. However, the Examiner did not acknowledge the amendment to claim 15 and repeated the same rejection in the final Office Action. Appellant believes that claim 15 correctly recites “*a* transaction privacy clearinghouse” (emphasis added). Appellant further believes that claims 16 and 17 properly recite “*the* electronic commerce transaction” (emphasis added) because claim 15 was amended to recite “*an* electronic commerce transaction.”

Accordingly, Appellant respectfully requests the withdrawal of the rejection of claim 15-17 under 35 U.S.C. § 112, second paragraph.

II. Claims 1-4, 6-11, 13, 14 and 26 are Patentable under 35 U.S.C. § 102(e) over Buckley.

Claims 1-4, 6-11, 13, 14 and 26 stand and fall together; claim 1 is the representative claim. Claim 1 claims the transaction device as described above.

Buckley discloses scanning a bar code with a handheld device, which transfers a request for information about the product to a server. Buckley is completely silent on whether or not the user's identity is revealed during the request. The Examiner agrees that Buckley does not directly teach Appellant's claim 1. However, the Examiner asserts that because Buckley does not teach that the user identity *is* disclosed, Buckley must be interpreted as teaching that the user identity *is NOT* disclosed. Although not stated as such, the Examiner is relying on an inherency argument to find that Buckley anticipates Applicant's claimed limitation of not revealing the user's identity.

Inherency cannot be established by probabilities or possibilities. Instead, the Examiner must present a factual or technically based argument that shows that the allegedly inherent limitation is necessarily present in the prior. Here there is not even a hint in Buckley concerning the user's identity so there are no facts that support the Examiner's assertion of inherency. Moreover, it is illogical to state that Buckley's failure to disclose revealing the user's identity means that Buckley inherently suggests the opposite, i.e., that the user's identity is disclosed. Thus, the Examiner argument is insufficient to establish a proper case of inherency under 35 U.S.C. § 102(e).

Accordingly, Appellant respectfully requests the withdrawal of the rejection of claims 1-4, 6-11, 13, 14 and 26 under 35 U.S.C. § 102(e) over Buckley.

III. Claims 5 and 12 are Patentable under 35 U.S.C. § 103(a) over Buckley and Ausems.

Claims 5 and 12 stand and fall together; claim 5 is the representative claim. Claim 5 depends from independent claim 1 and further claims various embodiment of the transaction device.

Ausems discloses an integrated user device that enables purchasing of an item by transmitting financial information to the point of sale terminal. Ausems is silent on whether or not the user's identity is revealed during the purchase.

Because neither Buckley nor Ausems disclose not revealing user identity, the combination cannot be properly interpreted as teaching or suggesting each and every limitation of claim 5.

Accordingly, Appellant respectfully requests the withdrawal of the rejection of claim 5 and 12 under 35 U.S.C. § 103(a) over Buckley and Ausems.

IV. Claims 15, 17, 18, 20-25, 27 and 29 are Patentable under 35 U.S.C. § 103(a) over Buckley and Walker.

Claims 15, 17, 18, 20-25, 27 and 29 stand and fall together; claim 18 is the representative claim. Claim 18 claims a system comprising the transaction device interacting and the privacy server as described above.

Walker discloses creating and encrypting a single use credit card number for electronic commercial transactions for transmission to a vendor. The vendor transmits the single use credit card number to the corresponding credit card issuer for authorization. Thus, Walker prevents the disclosure of the user's credit card number to a vendor, but does not teach or suggest that the user's identity is concealed as well. Therefore, Walker does not disclose Appellant's claimed privacy server that both authorizes transactions and does so without revealing the user's identity.

Because neither Buckley nor Walker disclose a privacy server as claimed, the combination cannot be properly interpreted as teaching or suggesting Appellant's invention as claimed in claim 18.

Accordingly, Appellant respectfully requests the withdrawal of the rejection of claims 15, 17, 18, 20-25, 27 and 29 under 35 U.S.C. § 103(a) over the combination of Buckley and Walker.

V. Claims 16, 19, and 28 are Patentable under 35 U.S.C. § 103(a) over Buckley, Walker and Peckover.

Claims 16, 19 and 28 stand or fall together; claim 19 is the representative claim. Claim 19 depends from independent claim 18 and further claims the transmission of eCoupons through the privacy server.

Peckover discloses representing consumers and providers in a virtual marketplace by personal agents that conceal the consumer's identity. However, the personal agents do

not authorize purchase transactions on the behalf of the consumer. Therefore, Peckover does not teach or suggest Appellant's claimed privacy server that both authorizes transactions and does so without revealing the user's identity.

Because neither Buckley, Walker, nor Peckover disclose a privacy server as claimed in claim 18, the combination cannot be properly interpreted as doing so.

Accordingly, Appellant respectfully requests the withdrawal of the rejection of claims 16, 19 and 28 under 35 U.S.C. § 103(a) over Buckley, Walker and Peckover.

VIII. CONCLUSION

For at least the reasons given above, Appellant submits that claims 7-13 and 15-17 are definite under 35 U.S.C. § 112, second paragraph, and that claims 1-29 are patentable over the cited prior art. Accordingly, Appellant respectfully requests the Board reverse the rejections of claims 7-13 and 15-17 under 35 U.S.C. § 112, reverse the rejections of claims 1-4, 6-11, 13, 14 and 26 under 35 U.S.C. § 102, reverse the rejections of claims 5, 12, 15-25 and 27-29 under 35 U.S.C. § 35 U.S.C. § 103(a), and direct the Examiner to enter a Notice of Allowance for Claims 1-29.

Fee for Filing a Brief in Support of Appeal

Enclosed is a check in the amount of \$150.00 to cover the fee for filing a brief in support of an appeal as required under 37 C.F.R. §§ 1.17(c) and 41.37(a).

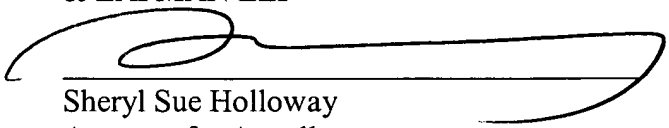
Deposit Account Authorization

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due. Furthermore, if an extension is required, then Appellant hereby requests such extension.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR
& ZAFMAN LLP

Dated: September 26, 2005



Sheryl Sue Holloway
Attorney for Appellant
Registration No. 37,850

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1026
(408) 720-8300 x309



Atty Docket No. 080398.P460

Patent

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:) Examiner: C. Hewitt, II
)
Hiroshi Ogino) Art Unit: 3621
)
ApplicationNo. 09/966,540) Confirmation No: 4648
)
Filed: September 27, 2001)
)
For: ELECTRONIC GATHERING OF)
PRODUCT INFORMATION AND)
PURCHASING OF PRODUCTS)
)

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**APPENDIX A FOR
APPEAL BRIEF UNDER 37 C.F.R. § 41.37**

1. (Original) A transaction device comprising:
 - a sensor module configured to receive a product identification for a product through a product tag; and
 - a communication module configured to transmit the product identification and a device identifier associated with the transaction device to a product server through a privacy server to obtain product information from the product server without providing an identification of a user of the transaction device.
2. (Original) The transaction device of claim 1, wherein the product server is to communicate product information back to the transaction device based on the product identification

3. (Original) The transaction device of claim 1, wherein the communication module is to transmit a request to purchase the product to the product server through the privacy server without providing the identification of the user of the transaction device.

4. (Original) The transaction device of claim 1, wherein the product tag includes product information for the product.

5. (Original) The transaction device of claim 1, wherein the transaction device is selected from the group consisting of a privacy card, digital wallet, and a privacy card configured to be coupled to a digital wallet.

6. (Original) The transaction device of claim 1, further comprising a product storage area configured to store the product information for a number of products.

7. (Previously Amended) An electronic transaction device comprising:

 a sensor module configured to receive a product identification for a product through a product tag associated with the product;

 a wireless module configured to transmit through a privacy system, the privacy system comprising a secure mechanism for correlating an identifier of the electronic transaction device with a user authorized to use the electronic transaction device; and

 a communication module configured to communicate the transaction device identifier and the product identification through the wireless module and the privacy system to perform a transaction for the product without providing an identification of a user of the transaction device.

8. (Original) The electronic transaction device of claim 7, further comprising:

 a display module configured to display the product information for the product received from the privacy system.

9. (Original) The electronic transaction device of claim 7, wherein the product tag for the product includes product information.

10. (Original) The electronic transaction device of claim 7, wherein the user of the electronic transaction device can purchase the product from a vendor through the secure mechanism using the wireless module based on the product identification and the transaction device identifier.

11. (Original) The electronic transaction device of claim 7, wherein the communication module is to transmit a request to purchase the product to the privacy system without providing the identification of the user of the transaction device.

12. (Original) The electronic transaction device of claim 7, wherein the electronic transaction device is selected from the group consisting of a privacy card, digital wallet, and a privacy card configured to be coupled to a digital wallet.

13. (Original) The electronic transaction device of claim 7, further comprising a product storage area configured to store product information for a number of products.

14. (Original) A method comprising:

receiving, at a transaction device, a signal based on a product tag associated with a product;

transmitting the product tag to a product server through a privacy server indicating a request of product information based on the product tag without providing an identity of a user of the transaction device; and

receiving the product information from the product server.

15. (Previously Amended) The method of claim 14, further comprising performing an electronic commerce transaction for the product with the product server through a

transaction privacy clearinghouse using a device identifier for the transaction device, wherein the identity of the user is not known to the product server.

16. (Original) The method as set forth in claim 15, wherein performing the electronic commerce transaction for the product includes receiving eCoupons related to the product from the vendor through the transaction privacy clearinghouse.

17. (Original) The method as set forth in claim 15, wherein performing the electronic commerce transaction for the product includes purchasing the product from the vendor through the transaction privacy clearinghouse.

18. (Original) An electronic system comprising:

- a personal transaction device configured to communicate with a product tag associated with a product to receive a product identification for the product, the personal transaction device having an identifier;

- a privacy server coupled selectively to the personal transaction device when a transaction related to the product is to be performed based on the product identification, said privacy server authorizing the transaction based upon the identifier and account information of a user that is authorized to use the transaction device, wherein the transaction is with a vendor of the product and wherein an identity of the user is not provided to the vendor.

19. (Original) The electronic system as set forth in claim 18, wherein the transaction includes transmitting eCoupons from the vendor to the transaction device through the privacy server without providing the identity of the user to the vendor.

20. (Original) The electronic system as set forth in claim 18, wherein the transaction includes purchasing the product from the vendor through the privacy server without providing the identity of the user to the vendor.

21. (Original) The electronic system as set forth in claim 18, wherein the personal transaction device is selected from the group consisting of a privacy card, digital wallet, and a privacy card configured to be coupled to a digital wallet.
22. (Original) The electronic system as set forth in claim 18, wherein the privacy server is further configured to selectively couple to a financial institution.
23. (Original) The electronic system as set forth in claim 18, wherein the privacy server further comprises a financial institution.
24. (Original) The electronic system as set forth in claim 18, wherein the privacy server comprises a secure database of transaction device information and user information, said database accessed for authorizing the transaction.
25. (Original) The electronic system as set forth in claim 18, wherein the privacy server is configured to interface to a financial processing system configured to perform financial transactions associated with the transaction.
26. (Original) A machine-readable medium that provides instructions, which when executed by a machine, cause said machine to perform operations comprising:
- receiving, at a transaction device, a signal based on a product -tag associated with a product;
 - transmitting the product tag to a product server through a transaction privacy clearinghouse indicating a request of product information based on the product tag; and
 - receiving the product information from the product server without providing an identity of a user of the transaction device.
27. (Previously Amended) The machine-readable medium of claim 26, further comprising performing an electronic commerce transaction for the product with the

product server through a transaction privacy clearinghouse using a device identifier for the transaction device, wherein the identity of the user is not known to the product server.

28. (Original) The machine-readable medium of claim 27, wherein performing the electronic commerce transaction for the product includes receiving eCoupons related to the product from the vendor through the transaction privacy clearinghouse.

29. (Original) The machine-readable medium of claim 27, wherein performing the electronic commerce transaction for the product includes purchasing the product from the vendor through the transaction privacy clearinghouse.